

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-17 and 19-31 are still pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

As the Examiner's rejection was similar to the rejection mailed on 5 February 2010, the applicants response to the Examiner's "Response to Arguments" section which is followed by a reproduction of the applicants' previous response from 7 June 2010.

Applicants' response to "Response to Arguments" section of the Office Action

(Paragraph letters track the letters used in the Office Action)

A. The Office Action continues to assert that Carson teaches a soap that is water soluble, but provides no evidence in support of this position. The statement that Carson teaches that their soap creates a bubble only confirms that gas is a requirement element of their invention, not that their soap is water soluble.

B. The argument here represents an interpretation of the transitional phrase "comprising" which is not permitted. "The PTO's construction here, though certainly broad, is unreasonably broad. The broadest-construction rubric coupled with the term "comprising" does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent. *See Schreiber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940)." *In re Suitco*, No. 2009-1418 (Fed. Cir. 4/14/2010).

Taken to extremes, the applicants' use of the transitional phase "comprising" does not include the inclusion of 99% by weight based on the total weight of the soap of concentrated

sulfuric acid. Likewise, one of ordinary skill in the art would recognize that when considering the applicants' claimed invention as a whole as well as the Carson reference as a whole, one would not seek to include gelatin in the applicants' soap composition as Carson has done.

D. While there is no limit to the number of references which may be combined, the applicants also note that it has long been held that it is improper to "[i]t is *impermissible* within the framework of section 103 *to pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

As such, when the Examiner elects to use a multiple references in combination to establish a prima facie case of obviousness, he buys the entire package of teachings, not an a la carte menu sufficient to address the elements of the applicants' claimed invention.

As cited in the recent "Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*" from the Federal Register (9/1/2010 – vol. 75, no. 169), "an obvious to try rationale may be proper when the possible options for solving a problem were known and finite. However, if the possible options were not either known or finite, then an obvious to try rationale cannot be used to support a conclusion of obviousness." *Rolls-Royce PLC v. United Technologies Corp.*, 603 F.3d 1325 (Fed. Cir. 2010).

As applied to the present rejection, not only is the combination of references relied upon not solving the same problem, but when considering the collective references as a whole, they represent virtually an infinite number of possible solutions to possible problems.

E./F. The response here misses the key point against trying to combine the references in the manner hoped for by the Examiner, i.e. the air bubbles are a key feature and required element of Carson's invention. It is well known that "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)(see also MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)(" "If the proposed modification or combination of the prior art would change the principle

of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”)

The decision to make or maintain a rejection in the face of all the evidence must show that it was based on the ***totality of the evidence***. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). For convenience, the applicants include their previous reply to help facilitate this decision based on the totality of the evidence in light of the applicants’ above counterarguments.

Applicants’ response from 7 June 2010

A. Claims 1-4, 6-10, 13-17, 19, 20, 22-25, 28, and 30 were rejected as allegedly being obvious by Carson, Jr. et al. (US 4,328,131 - “Carson”) in view of Hensley (US 2004-0029762 - “Hensley”) applicants request reconsideration of this rejection for the following reasons.

1. Background

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the art; and
- (D) Evaluating evidence of secondary considerations.

When ascertaining the differences between the prior art and the claims in issue, both the claimed invention and the prior art are considered as a whole.

Once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

2. Claims 1-4, 13, 14, 17, 22-25, 28 and 30 are unobvious because Carson does not teach a soap which dissolves in water

When reviewing the Carson reference as a whole, Carson's product does not refer to a product which dissolves in water as is currently being claimed. The passage referred to in Carson (col. 9, lines 45-60) as allegedly teaching dissolving in water does not teach this property:

"The elastic detergent bars of this invention possess an important novelty advantage over ordinary soap or detergent bars. They are especially attractive to children when they are molded into special shapes, such as the shapes of storybook, fairy tale or cartoon characters, people or animals and promote the enjoyment of bathing by infants and young children. *The elastic nature of the product allows a controlled dispensing of detergent and other foaming materials onto the skin or into the bath water in response to repeated squeezings and relaxings of the bar. Thus, the utilitarian detergent is also a delightful toy.* However, the product has various other advantages apart from its play value. The presence of gelatin adds a skin care ingredient to the composition and because of the bar's elasticity breakage in shipment or during storage is minimized." (emphasis added)

Moreover, Carson describes the essential elements of their invention in col. 2, lines 12-19 which includes gelatin:

"In accordance with the present invention an elastic detergent bar of improved elevated temperature stability in storage comprises about 20 to 80% of a mixture of anionic and amphoteric synthetic organic detergents in a proportion between about 1:5 and 5:1, *about 5 to 30% of gelatin*, about 5 to 50% of water and sufficient gas in small bubbles distributed throughout such bar so that the density of the bar is in the range of 0.5 to 0.98 g./cc." (emphasis added)

The properties of the gelatin is further explained in col. 5, lines 22-31 which includes a teaching that the behavior of gelatin in water is that it is "...insoluble in cold water, but swells rapidly in the presence of water until it has imbibed about 6 to 8 times its weight thereof and it melts to a viscous solution in water when warmed above 40° to 45°C."

Therefore, one of ordinary skill in the art would not view Carlson as teaching the applicants claimed solid soap preparation as amended for claims 1-4, 13, 14, 17, 22-25, 28 and 30.

3. Claims 1, 13, 17 and 18 are unobvious because neither Carson nor Hensley teach the requisite thickness of the claimed solid soap preparation

The Office Action acknowledges that Carson does not teach the thickness of the soap as not exceeding 5 mm and Hensley is relied upon for the teaching of a surfactant sheet which would suggest the requisite size claimed by the applicants.

However, regardless of the reference cited with respect to size of a surfactant sheet, the nature of Carlson's invention does not lend itself to combining the teachings of Hensley to produce a soap preparation which dissolves in water and does not exceed 5 mm.

As noted above, Carlson refers to a product which is capable of being squeezed multiple times and shows great elasticity (“relaxings”). In contrast, Hensley refers to a “non-elastic, frangible [breakable]” sheet soap” which one of ordinary skill in the art would view as being directed toward a soap with the opposite properties of Carlson.

4. Claims 10, 16, 18, 19 and 20 are unobvious

The Office Action alleges that the claimed effects and properties of the claimed soap preparation would be implicit (inherent) by a composition with all of the claimed ingredients. However, as noted above, Carson alone or in combination with Hensley does not teach all of the applicants’ claimed elements and therefore, there is no basis for an assertion of inherency.

Furthermore, Carson cannot refer to time of dissolution as the product itself does not dissolve, but merely acts as a vehicle to dispense detergent or other foaming materials.

If the basis for the rejection was on a broad interpretation of the applicants’ claim terms, it is noted that during patent examination, the claims are given the broadest reasonable interpretation *consistent with the specification*. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997)(emphasis added) and MPEP 904.01. However, as noted in the recent *In re Suitco* decision, such interpretations must be something more than the mere possibility of being encompassed by the interpretation of the claim term (“The PTO’s construction here, though certainly broad, is unreasonably broad. The broadest-construction rubric coupled with the term “comprising” does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent. See *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940).” *In re Suitco* (Fed. Cir. – April 14, 2010))

5. Claims 6-9 and 15 stand or fall with claim 1

As claims 6-9 and 15 are either directly or indirectly dependent upon claim 1, should the rejection of claim 1 be withdrawn, the rejection of claims 6-9 and 15 should also be withdrawn.

B. Claims 5, 26, 27, 29, and 31 were rejected as allegedly being obvious by Carson, Jr. et al. (US 4,328,131 - “Carson”) in view of Abbas et al. (US 6,555,509 - “Abbas”)

when taken with Roth et al. (Journal of Applied Polymer Science, - “Roth”) applicants request reconsideration of this rejection for the following reasons.

As claims 5, 26, 27, 29 and 31 are either directly or indirectly dependent upon claim 1, should the rejection of claim 1 be withdrawn, the rejection of 5, 26, 27, 29 and 31 should also be withdrawn.

With regard to the addition of Abbas and Roth, the applicants further note that these references must also be considered as a whole and not just for the isolated teachings relied upon in the Office Action, i.e. one of ordinary skill in the art confronted with all of the possible elements described in the disclosures of Carson, Abbas and Roth would be confronted with virtually an infinite number of possible parameters from which does not render obvious the applicants specific combination of elements.

With respect to the Roth article, the applicants note that it is directed to water-soluble films made of “cyanoethylated polyvinyl alcohol”. While it is true that Table II of Roth discloses properties of a “commercially available water-soluble film based on polyvinyl alcohol”, there is no disclosure of a water-soluble film containing air bubbles.

Indeed, the technical problem of incorporating air bubbles into a water-soluble film made of such film-forming agents has not been addressed in the Roth article. There is (according to our knowledge) no disclosure of a water-soluble films which permanently contains air bubbles. The reason is that such water-soluble films are manufactured by preparation of an aqueous solution which is spread out on to a substrate and dried. If one would try to incorporate air bubbles into such aqueous solutions, they would of course immediately leave the aqueous solution.

One option to prolong the duration of time of air bubbles in said aqueous solution would be the use of a gelling agent (as was done by Carson), because in this way the viscosity of the aqueous solution is increased. However, due to the presence of said gelling agent in the aqueous solution there is no rapid dissolution possible for the obtained film as claimed in the applicants’ claimed preparation as amended.

The present invention has a new approach for solving the problem of incorporating air bubbles into a water-soluble film, namely by utilizing soap. The soap acts as a foam former (compare claim 6) and stabilizes the air bubbles in said aqueous mixture during the process of drying. The resulting water-soluble film is still rapidly dissoluble.

C. Claims 11, 12, and 21 were rejected as allegedly being obvious by Carson, Jr. et al. (US 4,328,131 - “Carson”) in view of Hensley (US 2004-0029762 - “Hensley”) as applied to claim 1 and further in view of Schulerud (US 2,525,081 - “Schulerud”) applicants request reconsideration of this rejection for the following reasons.

As claims 11, 12 and 21 are either directly or indirectly dependent upon claim 1, should the rejection of claim 1 be withdrawn, the rejection of 11, 12 and 21 should also be withdrawn.

In addition, the applicants note that the Office Action acknowledges that “Carson do not teach drying process inside a heating tunnel. However, Schulerud teaches a method ... wherein the soap material is transported into a drying tunnel and its water is reduced to about 10%”.

As noted above, use of a drying tunnel for Schulerud was permissible because there was no requirement for the product of Shulerud to have air bubbles. One of ordinary skill in the art would not have looked to the teachings of Shulerud for combination with Carson as they were directed to producing different products.

Additionally, the process of Schulerud use “shear and compression” (see e.g. claim 1), no one of ordinary skill in the art would have sought to use this element for processing foamy masses, i.e. the combination of Carson, Hensley and Schulerud must also be considered as a whole and not just for the isolated teachings relied upon in the Office Action, i.e. one of ordinary skill in the art confronted with all of the possible elements described in the disclosures of Carson, Hensley and Schulerud would be confronted with virtually an infinite number of possible parameters from which does not render obvious the applicants specific combination of elements.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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